REMARKS

Amendments

Claims 1-27, 33-36, 38-46, 48-52 and 58 have been canceled, and claims 28-32 and 55-57. Upon entry of the amendment, claims 28-32, 37, 47 and 53-57 will be pending. Support for the amendments can be found in the specification, specifically on page 6, lines 28 through page 7, line 2; Example 1; the Figures, and in the claims as originally filed.

Supplemental Remarks regarding Commercial Sale

As argued previously, the commercial use and success of the claimed invention is demonstrated by: (1) delivery of the claimed invention to at least one large pharmaceutical company; and (2) commercial use of DeltaBase by three of the world's largest pharmaceutical companies, Merck, Pfizer and GlaxoSmithKline. DeltaBase incorporates the data set forth in the specification with regard to phenotypic analyses of the claimed mouse. With regard to supporting caselaw, Applicant respectfully directs the Examiner's attention to the following verbiage from the previously cited *Phillips Petroleum* case (*citing* Raytheon Co. v. Roper Corp. (724 F.2d 951, 959, 220 U.S.P.Q. 592 (Fed. Cir. 1983)):

> A correct finding of infringement of otherwise valid claims mandates as a matter of law a finding of utility under § 101. *See e.g., E.I. du Pont de Nemours & Co. v. Berkley & Co., supra,* 620 F.2d at 1258-61, 205 USPQ at 8-11; *Tapco Products Co. v. Van Mark Products Corp.*, 446 F.2d 420, 428, 170 USPQ 550, 555-56 (6th Cir.), *cert. denied*, 404 U.S. 986, 92 S. Ct. 451, 30 L. Ed. 2d 370 (1971). The rule is not related, as Raytheon argues, to whether a defendant may simultaneously assert non-utility and non-infringement; a defendant may do so. The rule relates to the time of decision not to the time of trial, and is but a *common sense approach to the law*. ***If a party has made, sold, or used a properly claimed device, and has thus infringed, proof of that device's utility is thereby established***. *People rarely, if ever, appropriate useless inventions*.

(*Phillips Petroleum Co. v. United States Steel Corp.*, 673 F. Supp. 1278, 1327, 6 U.S.P.Q.2d 1065 (D. Del. 1987), *affirmed*, 865 F.2d 1247, 9 U.S.P.Q.2d 1461 (Fed. Cir. 1989)). As succinctly stated by the Federal Circuit, ***common sense*** dictates that if a claimed invention has been sold and is being used, its utility is thereby established. As people rarely, if ever, appropriate useless inventions, large pharmaceutical companies, rarely if ever, purchase useless inventions.

Applicant also respectfully directs the Examiner's attention to a recently issued opinion from the Federal Circuit:

> Fisher did not present any evidence showing that agricultural companies have purchased or even expressed any interest in the claimed ESTs. And, it is entirely unclear from the record whether such business entities ever will. Accordingly, while commercial success may support the utility of an invention, it does not do so in this case. See Raytheon Co. v. Roper., 724 F.2d 951, 959 (Fed. Cir. 1983)(stating that proof of a utility may be supported when a claimed invention meets with commercial success).

(*In re Fisher*, 04-1465, 22 (Fed. Cir. 2005)). Unlike *Fisher*, Applicant has submitted evidence that the claimed invention has been purchased and delivered to at least one large pharmaceutical company. In addition, Applicant has demonstrated commercial use of the phenotypic data derived from Applicant's analyses of the claimed mouse by three pharmaceutical companies. Applicant respectfully submits that this evidence establishes the utility of the claimed invention.

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 502775.

Respectfully submitted,

9-8-05

Date

John E. Burke, Reg. No. 35,836
Greenberg Traurig LLP
1200 17th Street, Suite 2400
Denver, CO 80202
(303) 685-7411
(720) 904-6111 (fax)